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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,039	10/15/2001	Edward J. Kuebert	08049.0831	1583

22852 7590 12/22/2006
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EXAMINER

JABR, FADEY S

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/976,039	Applicant(s) KUEBERT ET AL.	
	Examiner Fadey S. Jabr	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims **1-30** remain pending and are again presented for examination.

Response to Arguments

1. Applicant's arguments with respect to claims **1-30** have been considered but are moot in view of the new ground(s) of rejection.
2. Claim **1** is objected to because of the following informalities: claims must be written in sentence form, and therefore must abide by proper punctuation. Claim 1 ends with a semicolon, as opposed to a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claim **3** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 3**, Claim 1 recites, "delivering the item to the second delivery point."
However, claim 3 recites "allowing the sender to specify whether to deliver to the first delivery point or the second delivery point", which is vague and indefinite. It is unclear to the

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Office how an item is delivered to a second delivery point, while at the same time allowing the sender to specify whether the item will be delivered to a first or second location. Appropriate correction is required in the indicated claim and any subsequent claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by

Fleckenstein et al., Pub. No. US2004/0211834 A1.

As per **Claim 1 and 11**, Fleckenstein et al. discloses a method for modifying item delivery

comprising:

- determining a first delivery point of the item (0009);
- notifying, based on the first delivery point, a recipient that the item is en route (0101);
- accepting at least one instruction designating a second delivery point (0013, 0015, 0043); and
- delivering the item to the second delivery point (0015).

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As per **Claim 2**, Fleckenstein et al. further discloses wherein accepting the at least one instruction comprises accepting at least one instruction from the recipient (0016).

7. Claims **6-7 and 13** are rejected under 35 U.S.C. 102(e) as being anticipated by Lopez, Pub. No. US2002/0029202 A1.

As per **Claim 6**, Lopez discloses a method comprising:

- notifying a sender of the item that the item is undeliverable (0035);
- accepting a disposition instruction from the sender (0035); and
- handling the item according to the disposition instruction (0035, 0040).

As per **Claim 7**, Lopez further discloses wherein the disposition instruction is an instruction to return the item to the sender (0035).

As per **Claim 13**, Lopez discloses a system comprising:

- means for notifying a sender of the item that the item is undeliverable (0035);
- means for accepting a disposition instruction from the sender; (0035); and
- means for handling the item according to the disposition instruction (0035, 0040).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims **3-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleckenstein et al., Pub. No. US2004/0211834 A1 in view of Lopez, Pub. No. US2002/0029202 A1.

As per **Claims 3-4**, Fleckenstein et al. fails to disclose notifying a sender of the item; and allowing the sender to specify whether to deliver to the first delivery point or the second delivery point. However, Lopez teaches notifying the sender that the mailpiece has been forwarded (0013). Further, Lopez teaches when an item is undeliverable to either forward the address to the recipient's forwarding address, otherwise return the item to the sender (0035, 0040). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include allowing the sender to specify delivery location of the mailpiece as taught by Lopez, because it allows the sender to be notified of the current status of the recipient's address when sending future mailpieces.

10. Claims **8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez, Pub. No. US2002/0029202 A1.

As per **Claims 8-10**, Lopez fails to *explicitly* disclose wherein the disposition instruction

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is an instruction to auction the item, donate the item, or dispose of the item. However, Lopez discloses instructions for when the mailpiece is undeliverable, i.e. forwarding the mailpiece or returning the mailpiece to the sender (0035). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Lopez and include various instructions for handling an item when the item is undeliverable, because it allows a sender to ensure proper handling of a mailpiece, which is intended for a recipient. Further, it allows the carrier to arrange for other means of storing the mailpieces, which were not delivered to the intended recipient.

11. Claims **5 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez, Pub. No. US2002/0029202 A1 in view of Kadaba, U.S. Patent No. 6,539,360 B1.

As per **Claims 5 and 12**, Lopez discloses a method comprising:

- determining a first delivery point of the item (0035);
- accepting a second delivery point from the sender (0035); and
- delivering the item to the second delivery point (0035, 0040).

Lopez fails to disclose notifying a sender that the item is en route. However, Kadaba teaches transmitting a tracking number to the consignor. Further, the consignor may be permitted access to determine whether the special handling has been applied (C. 7, lines 3-15, 61-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Lopez and include providing the sender of the mailpiece pertinent information such as a tracking number as taught by Kadaba, because it provides the sender with

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information, which allows the sender to determine if the special handling has been applied to the package.

12. Claims **14, 28 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleckenstein et al., Pub. No. US2004/0211834 A1.

As per **Claims 14 and 30**, Fleckenstein discloses a method of modifying item delivery comprising:

- determining a first delivery point of the item (0009);
- providing a notification to indicate that the item is en route to the first delivery point (0101).
- delivering the item to one of the first delivery point and second delivery point (0015).

Fleckenstein et al. fails to *explicitly* disclose *conditionally* accepting a second delivery point of the item; and delivering the item to one of the first delivery point and second delivery point based on the *conditional* acceptance of the second delivery point. However, Fleckenstein et al. discloses an active delivery indicator that is to indicate whether the alternate delivery instructions are to be followed by the delivery service (0066). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include accepting the indicated delivery points based on an indication as to whether the delivery instructions are to be followed, because it allows the delivery service to determine whether the delivery modification is feasible or cost-effective.

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As per **Claim 28**, Fleckenstein et al. discloses wherein conditionally accepting a second delivery point of the item is based on verifying an identity of a recipient for the item (0130).

13. Claims **15-20 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleckenstein et al., Pub. No. US2004/0211834 A1 in view of Lopez, Pub. No. US 2002/0029292 A1.

As per **Claims 15-16**, Fleckenstein et al. fails to disclose providing information to indicate that the item was (not) delivered to one of the first delivery point and second delivery point (are undeliverable). However, Lopez teaches notifying a sender when the mailpiece is forwarded to the recipient. Further, Lopez teaches notifying when the mailpiece was undeliverable (0035). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include notifying a sender when the mailpiece was or was not delivered as taught by Lopez, because it allows the sender to be notified of the current status of the recipient's address when sending future mailpieces.

As per **Claims 17-18**, Fleckenstein et al. fails to *explicitly* disclose accepting at least *one additional* delivery point for the item; and delivering the item to the at least one *additional* delivery point; and providing at least one *additional* notification based on delivery of the item to the at least one additional delivery point. However, Fleckenstein et al. discloses accepting an alternate delivery point and delivering the item to that alternate delivery point (0013, 0015, also

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see Figure 3A [Final Attempt]). Further, Fleckenstein et al. discloses notifying a recipient of an upcoming delivery (0101). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include accepting any number of delivery points and any number of notifications to the recipient, because it allows the delivery service to ensure proper delivery of the mailpiece to deliverable recipient location.

As per **Claim 19**, Fleckenstein et al. discloses wherein determining a first delivery point of the item comprises capturing an image of the item (0008).

As per **Claim 20 and 29**, Fleckenstein et al. fails to disclose requesting, from the sender, an approval of the second delivery point. However, Lopez teaches a return-to-sender determiner responsive to the sender return address indicator (0040). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include returning the mailpiece to the sender when the sender indicates return-to-sender service as taught by Lopez, because it allows the sender to be notified of the current status of the recipient's address when sending future mailpieces.

14. Claims **21-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleckenstein et al., Pub. No. US2004/0211834 A1 in view of Kadaba, U.S. Patent No. 6,539,360 B1.

As per **Claim 21-25**, Fleckenstein et al. disclosing providing a notification to indicate the item is en route to the first delivery point and capturing an image of the item (0008, 0101). Fleckenstein et al. fails to disclose that the notification includes one characteristic of the item, weight of the item, or size of the item. However, Kadaba teaches a package level detail notification transmitted to the carrier, or consignor or consignee which includes tracking number, item description, package weight, rate codes, special handling requirements and other pertinent information (C. 7, lines 3-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include providing a notification including pertinent information to various parties as taught by Kadaba, because it provides information to the parties involved in handling the mailpiece, which allows the involved parties to prepare to apply the special handling of the mailpiece.

15. Claims **26-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleckenstein et al., Pub. No. US2004/0211834 A1 in view of Jones, Pub. No. US2003/0233190 A1.

As per **Claim 26-27**, Fleckenstein et al. fails to disclose wherein providing the notification to indicate the item is en route to the first delivery point comprises providing information to indicate a time the item will arrive at the first delivery point. However, Jones teaches informing a user when the delivery vehicle is a particular time away from their residence, and also allowing the recipient to enter the amount of time to be notified of the package delivery (0008, 0095). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fleckenstein et al. and include informing

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the recipient of the time the mailpiece will arrive as taught by Jones, because it allows a recipient to adjust his/her schedule and avoid arrive too early or too late.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Fadey S Jabr
Examiner
Art Unit 3628

FSJ

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JOHN W. HAYES
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